

Appl. No. 10/672,698

Amdt. dated October 11, 2007

Reply to Final Office Action of August 15, 2007

**AFTER FINAL EXPEDITED PROCEDURE**

**REMARKS**

Claims 1 to 5, 8 to 16, 19 to 27, 30 to 38, and 41 to 44 were pending in the application at the time of final examination. Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44 stand rejected under 35 U.S.C. 112, first paragraph. Claim 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44 stand rejected under 35 U.S.C. 112, second paragraph. Claims 1, 3, 4, 8 to 10, 12, 14, 15, 19, 20, 21, 23, 25, 26, 30, 31, 32, 34, 36, 37, 39 to 41 to 43 stand rejected under 35 U.S.C. 103(a). Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth above and to include all of the limitations of the base claim and any intervening claims.

Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The rejection stated in part:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Said claims recite the limitation, "said user device comprises a smart card including a virtual machine". There does not exist in applicant's specification any indication of a smart card including a virtual machine.

Applicant respectfully traverses the § 112, first paragraph rejection of each of Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44. The Examiner attention is called to paragraph [0041] of the application as filed, which states:

[0041] According to another embodiment of the present invention, smart card 490 comprises VM 485.

Appl. No. 10/672,698

Amdt. dated October 11, 2007

Reply to Final Office Action of August 15, 2007

#### AFTER FINAL EXPEDITED PROCEDURE

In U.S. Patent Application Publication No. 2005/0069138 A1, this statement is at paragraph [0091]. Therefore, contrary to the statement in the rejection, the specification expressly recites that in one embodiment, the smart card includes a virtual machine (VM). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112, first paragraph rejection of each of Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44.

Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection stated in part:

Said claims recite the limitation, "said user device comprises a smart card including a virtual machine". It is unclear whether applicant intends the claim to mean that the user device comprises both a smart-card and a virtual machine or if the claim means the smart-card has the virtual machine inside itself.

Applicant respectfully traverses the § 112, second paragraph rejection of each of Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44. Applicant notes that the claims do not recite "said user device comprises a smart card and a virtual machine," but rather "a smart card including a virtual machine." The Examiner interpreted the claim properly and accordingly, in view of the specification, as quoted above, one of skill in the art can determine the metes and bounds of the invention. Applicant respectfully submits that there is no rationale for reading "and" into this limitation and rather the plain meaning of the limitation, as put forth in the rejection, is the proper interpretation. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 112, second paragraph rejection of each of Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44. Applicant respectfully

GUNNISON, McKay &  
HODGSON, L.L.P.  
Gordon West Office Plaza  
1900 Gordon Road, Suite 220  
Menlo Park, CA 94025  
(831) 655-0888  
Fax (831) 655-0889

Appl. No. 10/672,698

Amdt. dated October 11, 2007

Reply to Final Office Action of August 15, 2007

**AFTER FINAL EXPEDITED PROCEDURE**

notes that if the Examiner should disagree and the application is otherwise in condition for allowance in view of the following remarks, the Examiner is requested to telephone Applicant's attorney so that language can be worked out to move the application to allowance.

Claims 1, 3, 4, 8, 9, 12, 14, 15, 19, 20, 23, 25, 26, 30, 31, 34, 36, 37, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,966,002, hereinafter referred to as "Saez."

Applicant respectfully traverses the obviousness rejection of Claims 1, 12, 23, and 34 in view Saez. The rejection stated in part:

Saez does not explicitly teach:

The reception of said one or more obfuscated executable application programs occurs after obtaining a secret, which occurs in response to an enrollment request. In contrast, Saez teaches that the obfuscated executable application programs are received after the enrollment request is issued but before a secret is obtained. After further consideration, examiner determines that it would have been obvious, at the time of the invention to one of ordinary skill in the art to which the subject matter pertains to modify the Saez invention in order to allow the system taught by Saez to receive the program after the secret is obtained:

Sending the program after the secret is obtained would allow the server to encrypt the program based on the requestor's secret. The requestor can then receive the encrypted program and decrypt it accordingly using its secret. Examiner deems these processes of encryption/decryption are well known in the art.

Applicant respectfully notes that the rejection violates at least two requirements set forth by the MPEP for an obviousness rejection. First, the MPEP directs:

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

GUNNISON, MCKAY &  
HODGSON, L.L.P.  
Garden West Office Plaza  
1900 Garden Road, Suite 220  
Menlo Park, CA 94025  
(877) 655-0888  
(Fax (877) 655-0888)

Appl. No. 10/672,698  
Amdt. dated October 11, 2007  
Reply to Final Office Action of August 15, 2007

**AFTER FINAL EXPEDITED PROCEDURE**

MPEP § 2141, II., 8<sup>th</sup> Ed., Rev. 5, pg. 2100-117 (August 2005).

Second, the MPEP directs:

**V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART  
UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP § 2143.01, 8<sup>th</sup> Ed., Rev. 5, pg. 2100-129 (August 2005).

The rejection fails to meet these requirements. As quoted above, the rejection stated "Saez teaches that the obfuscated executable application programs are received after the enrollment request is issued but before a secret is obtained." This mischaracterizes the express teachings of Saez. As shown in Figs. 12 and 13 of Saez, the first operation in both processes (operations 1210 and 1220 in Fig. 12 and operation 1310 in Fig. 13) is that the user receives the software. Thus, Saez taught that the software was first obtained on the user computer and then all subsequent operation were performed. None of the subsequent operations in either Fig. 12 or 13 shows that the user computer receives any software. Accordingly, the rejection mischaracterizes the sequence of operations shown in Saez and therefore fails to consider the reference as a whole.

The rejection, as quoted above, purposes to move the first operation in Fig. 12 to after last operation 1270 "Server Transmits Decryption Key and/or Decryption Executable to User's Computer System." Thus, according to the rejection, the user would not have the software product or driver executable of Saez until after the transmission in operation 1270 of Saez.

However, Saez taught:

Then, at step 1230, and in response to input from the user, an access control executable portion of the software product (if an executable object) or of the driver executable (if the software product is a data object)

GUNNISON MCKAY &  
HODGSON, L.L.P.  
Golden West Office Plaza  
1800 Garden Road, Suite 220  
Monterey, CA 93940  
(415) 655-0880  
Fax (415) 655-0888

Appl. No. 10/672,698  
Amdt. dated October 11, 2007  
Reply to Final Office Action of August 15, 2007

**AFTER FINAL EXPEDITED PROCEDURE**

causes the user's computer to transmit a purchase request for partial or full access to the software product, and the server receives the purchase request. (Emphasis Added.)

Saez, Col. 18, lines 22 to 28.

Thus, according to Saez, a portion of the software product is used in step 1230 to transmit a purchase request. However, according to the proposed modification, the user has not received the software product in step 1230, because the modification to Saez moves the receipt of the software product to after step 1270.

Since, according to the rejection, the software product has not been received prior to step 1230, step 1230 will not work because the portion of the software product needed to send the purchase request is not available. Accordingly, the proposed modification "would render the prior art invention being modified unsatisfactory for its intended purpose." Therefore, according to the MPEP, "there is no suggestion or motivation to make the proposed modification."

Thus, Applicant has demonstrated that the rejection fails to comply with at least two requirements of the MPEP and so a prima facie obviousness rejection has not been made. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 12, 23, and 34.

Applicant respectfully traverses the obviousness rejection of Claims 3, 14, 25, and 36 in view Saez. To the extent that the obviousness rejection of these claims relies upon modifying Saez to move the receipt of the software, the comments above are applicable and incorporated herein by reference.

According to these claims, an enrollment request is received from a user device for receipt of one or more obfuscated applicant programs. The purchase request of Saez is not for receipt of software, but rather for use of software. The request for the software is different from the purchase request, because the request for the software is associated

GUNNISON, MCKAY &  
HODGSON, LLP  
One West Olive Plaza  
1900 Garden Road, Suite 220  
Menlo Park, CA 94025  
(831) 655-0880  
Fax (831) 655-0885

Appl. No. 10/672,698  
Amdt. dated October 11, 2007  
Reply to Final Office Action of August 15, 2007

#### AFTER FINAL EXPEDITED PROCEDURE

with step 1210 of Saez and not the purchase request of step 1230. In view of the proposed moving of the delivery of the software, step 1230 does not function as noted above and so there is no motivation according to the MPEP to make such a modification.

Further, the rejection failed to consider the claims as a whole. The claims recite "associating said secret with said target ID following said determining and authentication of said enrollment request." The rejection simplifies these claims to receiving, determining and transmitting. Thus, the rejection failed to consider the claims as a whole. There is no citation to any teaching or suggestion of the associating process, as recited in these claims, in the rejection.

Thus, Applicant has demonstrated that the rejection fails to comply with at least two requirements of the MPEP and so a prima facie obviousness rejection has not been made. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 3, 14, 25, and 36.

Claim 4 depends from Claim 3; Claim 15 from Claim 14; Claim 26 from Claim 25; and Claim 37 from Claim 36. Therefore, each of Claims 4, 15, 26, and 37 distinguishes over Saez for at least the same reasons as the claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 4, 15, 26, and 37.

Applicant respectfully traverses the obviousness rejection of Claims 8, 19, 30 and 41 in view of Saez. The above comments with respect to the proposed modification to Saez are incorporated herein by reference. Moving of the software delivery renders Saez incapable of issuing the purchase request and hence the server incapable of obtaining the system information etc. The required modification renders Saez unsuitable for its intended purpose and so a prima facie obviousness rejection has not been made. Applicant

GUNNISON, MCKAY &  
HODGSON, L.L.P.  
Garden West Office Plaza  
1900 Garden Road, Suite 220  
Menlo Park, CA 94025  
(831) 655-0888  
Fax (831) 655-0888

Appl. No. 10/672,698  
Amdt. dated October 11, 2007  
Reply to Final Office Action of August 15, 2007

#### AFTER FINAL EXPEDITED PROCEDURE

respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 8, 19, 30 and 41.

Claim 9 depends from Claim 8; Claim 20 from Claim 19; Claim 31 from Claim 30; and Claim 42 from Claim 41. Therefore, each of Claims 9, 20, 31, and 42 distinguishes over Saez for at least the same reasons as the claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 9, 20, 31, and 42.

Claims 10, 21, 32, and 43 stand rejected as under 35 U.S.C. § 103(a) as being unpatentable over Saez in view of U.S. Patent No. 6,098,056.

Applicant respectfully notes that, assuming the combination of references is correct, the additional information relied upon from the secondary reference fails to overcome the deficiency of the primary reference with respect to the independent claim from which each of these claims depends. In addition, as noted above, the double encryption with respect to the purchase request fails to teach anything concerning how one of skill in the art would split the encryption between steps 1210 and 1230. Moreover, it requires modifications to the encryption sequences in Saez that have not been acknowledged. General knowledge of double encryption fails to teach or suggest how to modify the primary reference so that it would still work for its intended purpose and how to modify Saez to meet the express sequence recited in these claims. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 10, 21, 32, and 43.

//

//

//

//

//

GUNNISON, MCKAY &  
HODGSON, LLP  
Garden Way Office Plaza  
1900 Garden Road, Suite 220  
Monterey, CA 93940  
(831) 655-0880  
Fax (831) 655-0888

Appl. No. 10/672,698

Amdt. dated October 11, 2007

Reply to Final Office Action of August 15, 2007

**AFTER FINAL EXPEDITED PROCEDURE**

Claims 1 to 5, 8 to 16, 19 to 27, 30 to 38, and 41 to 44 remain in the application. Claims 6, 7, 17, 18, 28, 29, 39, 40, and 45 to 48 were cancelled previously. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

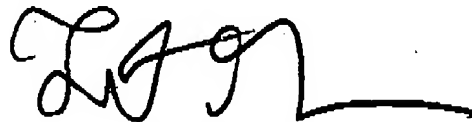
**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (571) 273-8300, on October 11, 2007.

Rivkah Young  
Rivkah Young

October 11, 2007  
Date of Signature

Respectfully submitted,



Forrest Gunnison  
Attorney for Applicant(s)  
Reg. No. 32,899